

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Thomas A. Saksa

Confirmation No.: 5070

Application No.: 09/940,363

Examiner: Amy R. Cohen

Filing Date: August 27, 2001

Group Art Unit: 2859

Title: MEASUREMENT AND MARKING DEVICE

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Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Nov. 9, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Thomas A. Saksa

By [Signature]

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas A. Saksa Examiner: Amy R. Cohen
Serial No.: 09/940,363 Art Unit: 2859
Filed: August 27, 2001 Docket No.: 10011180-1
Title: MEASUREMENT AND MARKING DEVICE

**APPEAL BRIEF TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF

This Appeal Brief is presented in support of the Notice of Appeal filed on November 9, 2004, from the Final Rejection mailed September 9, 2004, rejecting claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 of the above-identified application.

The U.S. Patent and Trademark Office is hereby authorized to charge **Deposit Account No. 08-2025** in the amount of **\$500.00** for Filing a Brief in Support of an Appeal as set forth under 37 C.F.R. 1.17(c). At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required under 37 C.F.R. 1.16, 1.17, 1.19, 1.20, and 1.21 to Deposit Account 08-2025.

Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35.

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REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

Appellant submits that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 are pending in the application (see Claims Appendix), and are the subject of the present Appeal. Claims 3, 10, 11, 14-21, and 24-26 were previously cancelled.

Claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 are rejected under 35 U.S.C. 103(a) as being anticipated by Wiklof et al. U.S. Patent No. 5,825,995 in view of Coulter et al. U.S. Patent No. 4,233,749. No claims have been allowed.

STATUS OF AMENDMENTS

No amendments have been entered subsequent to the Final Rejection mailed September 9, 2004. The claims listed in the Claims Appendix reflect the claims as of September 9, 2004.

SUMMARY OF CLAIMED SUBJECT MATTER

One aspect of the present invention, as claimed in independent claim 1, provides a measurement and marking device. The measurement and marking device includes a housing (20), a positional sensing assembly (30/30') mounted in the housing and adapted to sense a position of the housing relative to an object as the housing is moved along a surface of the object, and a printhead assembly (40) mounted in the housing and adapted to print on the surface of the object as the housing is moved along the surface of the object (see, e.g.,

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Specification at p. 4, line 24 - p. 6, line 2; and Figs. 1 and 2). The housing has a first side (22) adapted to be oriented substantially parallel with the surface of the object as the housing is moved along the surface of the object and includes a first opening formed in the first side and a second opening formed in the first side, wherein the positional sensing assembly communicates with the first side of the housing through the first opening and the printhead assembly communicates with the first side of the housing through the second opening (see, e.g., Specification at p. 7, line 11 - p. 8, line 4; and Figs. 3 and 4). The measurement and marking device also includes a controller (60) mounted in the housing and communicating with the positional sensing assembly and the printhead assembly, and a user interface (50) mounted on the housing and communicating with the controller (see, e.g., Specification at p. 6, line 3 - p. 6, line 26; and Figs. 1 and 2). The user interface includes an input (54) configured for operation by a user to record the position of the housing relative to the object, and the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user. In addition, the controller is adapted to operate the printhead assembly to print a mark on the surface of the object based on the position of the housing relative to the object as the housing is moved along the surface of the object (see, e.g., Specification at p. 9, line 8 - p. 10, line 30; and Figs. 6A-6E).

Another aspect of the present invention, as claimed in independent claim 22, provides a method of transferring a measurement of a first object (12a) to a second object (12b). The method includes moving a housing (20) along a surface (14a) of the first object, including orienting a first side (22) of the housing substantially parallel with the surface of the first object, sensing a position of the housing relative to the first object with a positional sensing assembly (30/30') mounted in the housing and communicating with the first side of the housing through a first opening in the first side of the housing as the housing is moved along the surface of the first object, and locating a feature of the first object, including receiving user input at the feature of the first object with an input (54) of a user interface (50) mounted on the housing and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller (60) mounted in the housing and communicating with the user interface (see, e.g., Specification at p. 9, line 8 - p. 10, line 4; and Figs. 6A-6B; see also Specification at p. 11, line 19 - p. 14, line 30; and Figs. 7-11). The

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method also includes moving the housing along a surface (14b) of the second object, including orienting the first side of the housing substantially parallel with the surface of the second object, sensing a position of the housing relative to the second object with the positional sensing assembly as the housing is moved along the surface of the second object, and printing a mark (82) representing the feature of the first object on the surface of the second object with a printhead assembly (40) mounted in the housing and communicating with the first side of the housing through a second opening in the first side of the housing when the position of the housing relative to the second object coincides with the position of the housing at the feature of the first object (see, e.g., Specification at p. 10, line 5 - p. 10, line 30; and Figs. 6C-6E; see also Specification at p. 11, line 19 - p. 14, line 19; and Figs. 7-10).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 are rejected under 35 U.S.C. 103(a) as being anticipated by Wiklof et al. U.S. Patent No. 5,825,995 in view of Coulter et al. U.S. Patent No. 4,233,749.

ARGUMENT

Rejections Under 35 U.S.C. §103

A. Applicable Law

Under 35 U.S.C. §103, the Examiner has the burden to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). These three criteria are also set forth in M.P.E.P §706.02(j). Even when obviousness is based on a single reference, there must be a showing of suggestion or motivation to modify the teachings of that reference. *In*

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re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). In performing the obviousness inquiry under 35 U.S.C. §103, the Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

B. Rejection of claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 under 35 U.S.C. §103(a)

Because the rejection of claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 under 35 U.S.C. §103(a) as being unpatentable over Wiklof et al. U.S. Patent No. 5,825,995 in view of Coulter et al. U.S. Patent No. 4,233,749, in the Final Rejection mailed September 9, 2004, fails to establish a *prima facie* case of obviousness, the rejection of claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 is not correct and should be withdrawn.

The measurement and marking device of independent claim 1 includes a user interface mounted on the housing and communicating with the controller, with the user interface including an input configured for operation by a user to record the position of the housing relative to the object, wherein the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user. In addition, the method of transferring a measurement of a first object to a second object of independent claim 22 includes locating a feature of the first object, with locating the feature of the first object including receiving user input at the feature of the first object with an input of a user interface mounted on the housing and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing and communicating with the user interface.

Regarding claim 1, the Examiner contends that the Wiklof et al. patent discloses a user interface (128) mounted on the housing and communicating with the controller, with the user interface including an input configured for operation by a user to record the position of the housing relative to the object (Final Rejection mailed September 9, 2004, at sect. 2, pp. 2-3). Regarding claim 22, the Examiner contends that the Wiklof et al. patent discloses locating a feature of the first object, including receiving user input at the feature of the first object with an input of a user interface mounted on the housing and recording the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing and communicating with the user interface (Final Rejection mailed September 9, 2004, at sect. 2, pp. 4-5).

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The Examiner recognizes, however, that the Wiklof et al. patent does not disclose, regarding claim 1, a measurement and marking device wherein the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user, and does not disclose, regarding claim 22, a method of transferring a measurement including receiving and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing (Final Rejection mailed September 9, 2004, at sect. 2, p. 5).

The Examiner contends that the Coulter et al. patent discloses a measurement and marking device wherein the controller (34) is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user (Final Rejection mailed September 9, 2004, at sect. 2, p. 5). In addition, the Examiner contends that the Coulter et al. patent discloses a method of transferring a measurement of a first object to a second object including receiving user input at a feature of the first object and storing the position of the housing at the feature of the first object as a measurement of the first object with a controller (34) mounted in the housing (Final Rejection mailed September 9, 2004, at sect. 2, p. 6). As such, the Examiner suggests that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the measurement and marking device of Wiklof et al. to record the position of the housing relative to the object when the input of the user interface is operated by the user and receive and store a predetermined position for printing of the measurement marking, as taught by Coulter et al. (Final Rejection mailed September 9, 2004, at sect. 2, p. 7).

Appellant submits that modifying the Wiklof et al. patent in view of the Coulter et al. patent, in the manner suggested by the Examiner, does not teach or suggest all of the limitations of the present claims. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Wiklof et al. patent discloses a handheld mobile printer (100) including a user input interface 128 (Fig. 3). The user input interface 128, however, does not include an input configured for operation by a user to record the position of the housing relative to a object. Rather, the user input interface of the Wiklof et al. patent is disclosed as only including an

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image rotation four-position switch 132 which allows the user to select an orientation for the printed image, a trigger switch 131 which prevents accidental activation of the printer, an "X-out" switch 135 which allows the printer to be used to overwrite existing images, and a format select switch 134 (col. 4, lines 37-44).

The Coulter et al. patent discloses an apparatus for marking preselected measurements on an object (col. 2, lines 22-23), and contemplates use of the apparatus when measurement only is desired without marking and such measurement is to be read out on display 32 (col. 6, lines 30-32). The apparatus of the Coulter et al. patent, however, does not receive user input at a user interface, such as keyboard 28, when such a measurement is made. More specifically, none of the keys 36 of keyboard 28 of the apparatus of the Coulter et al. patent is operated as an input by a user when the measurement is made. The apparatus of the Coulter et al. patent, therefore, does not store a position of the housing relative to or at a feature of an object as a measurement of the object when an input of the user interface is operated, as claimed in independent claims 1 and 22.

Accordingly, incorporating the teaching of the Coulter et al. patent in the Wiklof et al. patent, in the manner suggested by the Examiner, would not overcome the shortcomings of the Wiklof et al. patent and, therefore, would not result in the recited claims. Thus, Appellant submits that the combination of the Wiklof et al. and Coulter et al. patents does not teach or suggest each and every element of independent claim 1 nor independent claim 22. More specifically, with respect to the Wiklof et al. and Coulter et al. patents, neither of these patents, individually or in combination, teach or suggest a measurement and marking device including an input configured for operation by a user to record the position of the housing relative to the object, wherein the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user, as claimed in independent claims 1, nor a method of transferring a measurement including receiving user input at the feature of the first object with an input of a user interface mounted on the housing and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing, as claimed in independent claim 22.

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1 and 22, and that independent claims 1 and

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22 are each patentably distinct from the Wiklof et al. and Coulter et al. patents. As dependent claims 2, 4-9, 12, 13, 30, 31, and 34 further define patentably distinct claim 1, and dependent claims 23, 27-29, 32, 33, and 35 further define patentably distinct claim 22, Appellant submits that dependent claims 2, 4-9, 12, 13, 23, and 27-35 are also patentably distinct from the Wiklof et al. and Coulter et al. patents. Appellant, therefore, respectfully submits that the rejection of claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and that claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 should be allowed.

CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejection of pending claims 1, 2, 4-9, 12, 13, 22, 23, and 27-35 is not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

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Any inquiry regarding this Appeal Brief should be directed to either Gregg W. Wisdom at Telephone No. (360) 212-8052, Facsimile No. (360) 212-3060 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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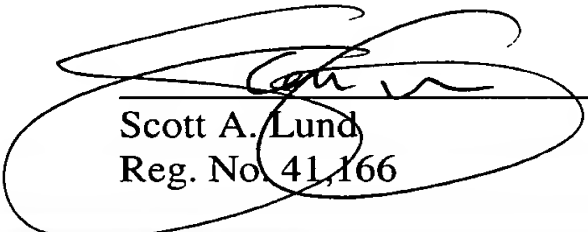
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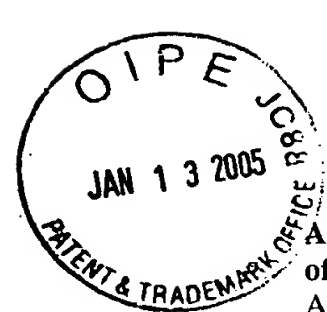


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By 

Name: Scott A. Lund



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CLAIMS APPENDIX

1. (Previously Presented) A measurement and marking device, comprising:
 - a housing;
 - a positional sensing assembly mounted in the housing and adapted to sense a position of the housing relative to an object as the housing is moved along a surface of the object;
 - a printhead assembly mounted in the housing and adapted to print on the surface of the object as the housing is moved along the surface of the object;
 - a controller mounted in the housing and communicating with the positional sensing assembly and the printhead assembly, wherein the controller is adapted to operate the printhead assembly to print a mark on the surface of the object based on the position of the housing relative to the object as the housing is moved along the surface of the object; and
 - a user interface mounted on the housing and communicating with the controller, the user interface including an input configured for operation by a user to record the position of the housing relative to the object,
- wherein the housing has a first side adapted to be oriented substantially parallel with the surface of the object as the housing is moved along the surface of the object and includes a first opening formed in the first side and a second opening formed in the first side,
- wherein the positional sensing assembly communicates with the first side of the housing through the first opening and the printhead assembly communicates with the first side of the housing through the second opening,
- wherein the controller is adapted to store the position of the housing relative to the object as a measurement of the object when the input of the user interface is operated by the user.

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2. (Original) The measurement and marking device of claim 1, wherein the positional sensing assembly is adapted to sense a position of the housing relative to a first object and measure a dimension of the first object as the housing is moved along a surface of the first object, wherein the positional sensing assembly is adapted to sense a position of the housing relative to a second object as the housing is moved along a surface of the second object, and wherein the controller is adapted to operate the printhead assembly to print the mark on the surface of the second object based on the dimension of the first object and the position of the housing relative to the second object as the housing is moved along the surface of the second object.

3. (Cancelled)

4. (Previously Presented) The measurement and marking device of claim 2, wherein the controller is adapted to operate the printhead assembly to print the mark on the surface of the second object based on the position of the housing relative to the first object when the input is operated by the user and the position of the housing relative to the second object as the housing is moved along the surface of the second object.

5. (Original) The measurement and marking device of claim 1, wherein the controller is adapted to operate the printhead assembly to print a plurality of markings on the surface of the object at predetermined intervals as the housing is moved along the surface of the object.

6. (Original) The measurement and marking device of claim 5, wherein the plurality of markings represent one of standard measurements and scaled measurements.

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7. (Original) The measurement and marking device of claim 1, wherein the printhead assembly is adapted to print at least one of graphics and text on the surface of the object as the housing is moved along the surface of the object.
8. (Original) The measurement and marking device of claim 1, wherein the positional sensing assembly includes a wheel rotatably mounted in the housing, wherein the wheel is adapted to contact the surface of the object and rotate as the housing is moved along the surface of the object, and wherein the controller is adapted to determine the position of the housing relative to the object based on rotation of the wheel.
9. (Original) The measurement and marking device of claim 1, wherein the positional sensing assembly includes an optical sensor mounted in the housing, wherein the optical sensor is adapted to sense the surface of the object as the housing is moved along the surface of the object, and wherein the controller is adapted to determine the position of the housing relative to the object based on the surface of the object.
10. (Cancelled)
11. (Cancelled)
12. (Previously Presented) The measurement and marking device of claim 1, wherein the printhead assembly includes a plurality of orifices formed in a front face thereof, wherein the front face communicates with the first side of the housing.
13. (Original) The measurement and marking device of claim 1, further comprising:
a power supply mounted in the housing, wherein the power supply supplies power to the measurement and marking device.

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14-21. (Cancelled)

22. (Previously Presented) A method of transferring a measurement of a first object to a second object, the method comprising:

moving a housing along a surface of the first object, including orienting a first side of the housing substantially parallel with the surface of the first object;

sensing a position of the housing relative to the first object with a positional sensing assembly mounted in the housing and communicating with the first side of the housing through a first opening in the first side of the housing as the housing is moved along the surface of the first object;

locating a feature of the first object, including receiving user input at the feature of the first object with an input of a user interface mounted on the housing and storing the position of the housing at the feature of the first object as the measurement of the first object with a controller mounted in the housing and communicating with the user interface;

moving the housing along a surface of the second object, including orienting the first side of the housing substantially parallel with the surface of the second object;

sensing a position of the housing relative to the second object with the positional sensing assembly as the housing is moved along the surface of the second object; and

printing a mark representing the feature of the first object on the surface of the second object with a printhead assembly mounted in the housing and communicating with the first side of the housing through a second opening in the first side of the housing when the position of the housing relative to the second object coincides with the position of the housing at the feature of the first object.

23. (Previously Presented) The method of claim 22, wherein sensing the position of the housing relative to the first object includes measuring a dimension of the first object, wherein locating the feature of the first object includes measuring at least one of a

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dimension to the feature of the first object and a dimension of the feature of the first object, and wherein printing the mark on the surface of the second object includes printing the mark on the surface of the second object when the position of the housing relative to the second object coincides with the at least one of the dimension to the feature of the first object and the dimension of the feature of the first object.

24. (Cancelled)

25. (Cancelled)

26. (Cancelled)

27. (Previously Presented) The method of claim 22, wherein printing the mark on the surface of the second object includes printing at least one of graphics and text on the surface of the second object.

28. (Previously Presented) The method of claim 22, wherein moving the housing along the surface of the first object and the surface of the second object includes contacting the surface of the first object and the surface of the second object with a wheel rotatably mounted in the housing and rotating the wheel, and wherein sensing the position of the housing relative to the first object and the second object includes determining the position of the housing relative to the first object and the second object based on rotation of the wheel.

29. (Previously Presented) The method of claim 22, wherein moving the housing along the surface of the first object and the surface of the second object includes sensing the surface of the first object and the surface of the second object with an optical sensor mounted in the housing, and wherein sensing the position of the housing relative to the

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Title: MEASUREMENT AND MARKING DEVICE

first object and the second object includes determining the position of the housing relative to the first object and the second object based on the surface of the first object and the surface of the second object, respectively.

30. (Previously Presented) The measurement and marking device of claim 1, wherein the positional sensing assembly is adapted to measure a dimension of a first object as the housing is moved along a surface of the first object, and wherein the controller is adapted to operate the printhead assembly to print the mark on a surface of a second object at the dimension of the first object as the housing is moved along the surface of the second object.

31. (Previously Presented) The measurement and marking device of claim 1, wherein the positional sensing assembly is adapted to measure a dimension of a first object as the housing is moved along a surface of the first object, and wherein the controller is adapted to operate the printhead assembly to print the mark on a surface of a second object at predetermined intervals within the dimension of the first object as the housing is moved along the surface of the second object.

32. (Previously Presented) The method of claim 22, wherein sensing the position of the housing relative to the first object includes measuring a dimension of the first object, and wherein printing the mark on the surface of the second object includes printing the mark on the surface of the second object at the dimension of the first object.

33. (Previously Presented) The method of claim 22, wherein sensing the position of the housing relative to the first object includes measuring a dimension of the first object, and wherein printing the mark on the surface of the second object includes printing the mark on the surface of the second object at predetermined intervals within the dimension of the first object.

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34. (Previously Presented) The measurement and marking device of claim 1, wherein the controller is adapted to operate the printhead assembly to print the mark on the surface of the object based on the position of the housing relative to the object and the measurement of the object as stored by the controller.

35. (Previously Presented) The method of claim 22, wherein printing the mark on the surface of the second object includes printing the mark on the surface of the second object based on the position of the housing relative to the second object and the measurement of the first object as stored by the controller.